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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

STONE, JONATHAN D

ART UNIT PAPER NUMBER

2178

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/452,925

Applicant(s)

TAKAHASHI, KUNIKAZU

Examiner

Jonathan D Stone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Application filed on 12/29/99.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. Claims 1-17 are currently pending in the case. Claim 1 is an independent claim. Claim 18 is a nonelected claim.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to an electronic dictionary, classified in class 715, subclass 532.
 - II. Claim 18, drawn to a networking system, classified in class 709, subclass 238.
5. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination is drawn towards a network for information entry with a plurality of consoles. The subcombination has separate utility such as providing an electronic dictionary.
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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7. Additionally, because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

8. A telephone call was made to Mr. Samson Helfgott on 3/26/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

9. A call was received from Mr. Tom Bean on 3/28/03 and resulted in the election of invention I without traverse.

Specification

10. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Dictionary for searching words cut out from an entered string.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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13. **Regarding independent claim 1**, the claim recites the limitation “displaying these all at once.” It not particularly clear as to what “these all” refers. The office suggests explicitly claiming what is to be displayed to avoid ambiguities.

14. **Regarding dependent claims 2-17**, these claims are rejected for fully incorporating the deficiencies of their respective base claims.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (USPN 5678054 – filing date 10/5/1994) in view of Redfern (USPN 6078914 – filing date 12/9/1996).

16. **Regarding independent claim 1**, Shibata discloses a device that has a keyboard for entering string information (abstract, Fig 1; compare with “*an alphanumeric entry...information*”). Shibata also discloses a display for displaying data contained in memory (predetermined strings) that are associated with the input (col 1, ln 55-64; compare with “*a display...screen*”). Shibata also discloses a dictionary (Fig 2, and col 2, ln 51-55). Shibata discloses the common functions of a dictionary as having a primary data corresponding to a

secondary data. Among this secondary data are synonyms that are linked to the primary data (Fig 1, col 10-22; compare with "*a word...keywords*").

Shibata discloses displaying all of the secondary data at once (col 1, ln 58-64). Shibata does not explicitly disclose cutting out strings in order to search through the dictionary. However, Redfern teaches extracting relevant terms (col 4, ln 35-43). These terms are then used to search databases and retrieve associated data when matches are made (col 8, ln 66 – col 9, ln 12). Redfern also discloses the addition of alternative/synonym words to the search (col 3, ln 10-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Shibata and Redfern, using Redfern's search method to query the dictionary and return data to be displayed as disclosed by Shibata (compare with "*an alphanumeric information...unit.*"). Such a combination would have improved data searching by customizing the search to the user's input, freeing the user from performing multiple searches.

17. **Regarding dependent claim 4**, Shibata and Redfern do not explicitly disclose using a second set of keywords to extract a primary keyword. However, Shibata discloses obtaining synonyms as secondary data from a dictionary (col 1, ln 10-14). Redfern discloses the use of alternative/synonym words to supplement a database search (col 3, ln 10-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Shibata's teaching of using synonyms for searching supplementing in Shibata's invention. Such a combination would have expanded the search capabilities of the dictionary by applying its own related secondary keys to search for a primary key, allowing for more strings to be displayed to a user by following different relations.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata in view of Redfern and in further view of Luciw (USPN 5625814 – filing date 5/15/1995).

18. **Regarding dependent claim 2**, Shibata and Redfern do not explicitly disclose successively cutting out strings to match in a dictionary. However, Luciw does disclose analyzing an input string that extracts and checks a string for a meaning. It then successively extracts strings until the entire string is analyzed (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Luciw with the inventions of Shibata and Redfern. Such a combination would have furthered the idea of customized searching by analyzing the entire string to create an appropriate query.

Claims 3, 6-8, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata in view of Redfern and in further view of Microsoft Bookshelf Basics Edition (herein Bookshelf; Microsoft Corporation (c) 1987-1996).

19. **Regarding dependent claim 3**, Shibata and Redfern do not explicitly disclose a dictionary containing conjugated strings. However, Bookshelf teaches a dictionary that does contain conjugated forms of words (Figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Bookshelf with the inventions of Shibata and Redfern. Such a combination would have made the dictionary more flexible by enabling the search of words in conjugated forms, as was known and typical of dictionaries in the art at the time of the invention.

20. **Regarding dependent claim 6**, Shibata and Redfern do not explicitly disclose designating keywords displayed all at once as provisional primary entries and displaying them in a first color. However, Bookshelf teaches the display of a set of keywords all at once in a certain configuration and uses different colored text for certain terms (Figure 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Shibata, Redfern, and Bookshelf and use the text display and text colors to indicate provisional primary entries. This combination would have created a dictionary that a user could more quickly and easily recognize specific word types (e.g. via color), alleviating any user hassle of determining these elements by themselves.

21. **Regarding dependent claims 7-8**, Bookshelf teaches a display field in which a word is replaced by another word (Figure 4) that is manually selected from a list produced from a first input (Figure 3), or may be changed via keyboard.

22. **Regarding dependent claims 14-17**, Bookshelf teaches an input method that enables a user to input a string and to press enter to confirm the entry (Figure 6). While the user enters information, display fields are sequentially selected according to the partial input (Figures 7 and 6). Upon the enter instruction, the input is confirmed and the input is completed automatically (Figure 4). After the input is confirmed, the confirmed output is shown highlighted in a different

color (Figure 4). Although Bookshelf does not explicitly teach the manual confirmation of all display fields of the primary entry state, it would have been obvious to one of ordinary skill in the art at the time of the invention to extend the entry confirmation method as discussed above to include the confirmation of all display fields. Such a modification would have given the user more control over the results and would have resulted in a user receiving more personalized findings.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata in view of Redfern and in further view of Saito (USPN 6201894 – filing date 1/22/1997).

23. **Regarding dependent claim 5**, Shibata and Redfern do not explicitly disclose using a form dictionary to store and retrieve display formats. However, Saito discloses a format dictionary used to store format and an identifier for associating a format with an input (claim 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the inventions of Shibata and Redfern to include a format dictionary as disclosed by Saito. Such a combination would have enabled a user to store and recall words in specific formats.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata in view of Redfern and in further view of Fujisawa et al (herein Fujisawa; USPN 4654873 – filing date 10/30/1985) and Houser et al (herein Houser; USPN 5774859 – filing date 1/3/1995).

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24. **Regarding dependent claims 9-13**, Shibata teaches the use of a keyboard for entering input (abstract). Shibata and Redfern do not explicitly disclose using a handwritten or speech input. However, Howser discloses evaluating speech input and receiving vocabulary (abstract). Fujisawa discloses the analysis of handwritten input and converting it into digital form (col 1, ln 45 – col 2, ln 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Shibata, Redfern, Houser, and Fujisawa, including dividing up the handwritten text for analysis in the dictionary. It follows that various input methods necessitated by handwritten and speech input methods would also have been obvious to one of ordinary skill in the art at the time of the invention. This combination would have extended the invention by allowing multiple input methods, enabling a variety of users to access the invention (e.g. a user who is unable to use a keyboard).

25. Prior art made of record and not relied upon is considered pertinent to disclosure.

| | | | |
|------------------|-------------------------|------------------|-----------------|
| Julliard | U.S. Patent No. 6202064 | issued 3/13/2001 | filed 6/18/1998 |
| Tolin et al | U.S. Patent No. 5490061 | issued 2/6/1996 | filed 9/5/1989 |
| Yoshimura et al | U.S. Patent No. 4688192 | issued 9/18/1987 | filed 6/28/1984 |
| Poznanaski et al | U.S. Patent No. 5978798 | issued 11/2/1999 | filed 6/13/1997 |
| Crawford et al | U.S. Patent No. 5649221 | issued 7/15/1997 | filed 9/14/1995 |
| Sullivan et al | U.S. Patent No. 5956711 | issued 9/21/1999 | filed 1/16/1997 |

Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D Stone whose telephone number is (703) 305-7854.

The examiner can normally be reached on M-F 9-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications. Responses to this action may be mailed to:


Commissioner of Patents and Trademarks
Washington, D.C. 20231

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive
Arlington, VA, Fourth Floor (receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JDS
April 3, 2003


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100